REMARKS

Applicant acknowledges receipt of the Office action dated September 14, 2007. In that action, the Examiner: (1) rejected claims 33, 35, 38, 41, 42, 44, 62 and 64 under 35 U.S.C. 102(b) as being anticipated by *Bufkin* US 3,847,040; (2) rejected claims 33-35, 38, 42-48, 51, 53-55, 62 and 64 under 35 U.S.C. 102(b) as being anticipated by *Gazel-Anthoine* US 5,271,298; (3) rejected claims 33-35, 38, 42, 44-48, 51, 53, 55 and 62-64 under 35 U.S.C. 102(b) as being anticipated by *Dlask et al.* US 6,070,500; (4) objected to claims 36, 37, 39, 40, 49, 50 and 52 as being dependent upon a rejected based claim; and (5) allowed claims 56-61. Applicant respectfully requests the Examiner to reconsider his rejections in view of the attached amendments and following remarks.

Status of the claims

Claims 33-64 are pending.

Claims 1-32 were previously canceled.

Claims 33, 45 and 62 are currently amended.

Claim Rejections Under 35 U.S.C. 102(b)

The Examiner rejected the claims listed above as anticipated under 35 U.S.C. 102(b). In order to establish a *prima facie* case of anticipation, the Examiner must show that each and every element of the claims is disclosed, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). If a single element is not found in the prior art reference, the claims are not anticipated. Additionally, the Federal Circuit has held that "[t]o anticipate, every element and limitation of the claimed invention must be found in a single prior art reference ***arranged as in the claim***." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001). Thus, an invention is anticipated only when the ***same***

device having all the elements contained in the claim limitations, is described in a single prior art reference. For the reasons discussed below, neither *Bufkin*, *Gazel-Anthoine* nor *Dlask* teach every element of the claimed arrangements.

Bufkin

The Examiner rejected independent claims 33 and 62 as being anticipated by *Bufkin*. *Bufkin* discloses a powered tong for limiting travel of and forces exerted by the radially movable gripping means. *Bufkin*, col. 2, ll. 49-53. The powered tong 17 includes a housing 21. The housing 21 has internal camming surfaces 24 for receiving cam followers 27. The cam followers 27 include roller bearings 30 and a die or insert holder 29 retaining dies or inserts 31. While the surfaces of the bearings 30 contact and cammingly engage the cam surfaces 24, the bearings 30 transfer forces to the insert holder 29 (and thereby indirectly to the insert 31) via the pins or axles 34.

With respect to claim 33, the claimed gripping apparatus includes a wrench body, an insert holder coupled to the wrench body, an insert and a cam member disposed between the insert holder and the insert. A first camming surface of the cam member rotationally engages an inner surface of the insert while a second camming surface of the cam member rotationally engages a surface of the insert holder. First, the cam members 30 of *Bufkin* are not disposed between the insert holder 29 and the insert 31, contrary to the claimed arrangement. Instead, the cam members 30 are disposed on an opposite side of the insert holder 29 from the insert 31, attached to the insert holder 29 by the pin 34. Second, the cam members 30 of *Bufkin* do not have first and second camming surfaces rotationally engaging both the insert and the insert holder. Instead, the cam members 30 have only a single continuous camming surface for rolling along the cam surface 24, and the engagement between the cam members 30 and the holder and insert assembly is achieved through the pin 34. The features taught by *Bufkin* are simply not

arranged as in claim 33. While the *Bufkin* arrangement may suffice for limiting movement of the cam followers 27 and preventing excessive gripping forces, it simply does not achieve the desired results as discussed throughout the present specification.

With respect to claim 62, the claimed method includes forcing the insert against the first curved camming surface of the cam member and forcing the second curved camming surface against the insert holder, thereby rotating the cam member and intensifying the gripping force. As previously explained, the *Bufkin* arrangement includes the insert 31 immovably coupled to the insert holder 29 and a cam member 30 attached behind the insert holder 29 via the pin 34 so that the entire cam follower assembly 27 can roll along the cam surface 24 on the tong body 21. Such an arrangement cannot disclose forcing the insert against the first camming surface of the cam member and also forcing the second camming surface of the cam member against the insert holder, thereby rotating the cam member. The continuous cam surface of the *Bufkin* cam member 30 only forces against the cam surface 24 of the tong body. Furthermore, it was previously explained that the *Bufkin* arrangement limits movement and excessive forces, while claim 62 includes intensifying the gripping force.

For at least these reasons, *Bufkin* does not anticipate independent claims 33 and 62. Claims 35, 38, 41, 42 and 44 are not anticipated by *Bufkin* at least because they depend from claim 33 and add features thereto. Claim 64 is not anticipated by *Bufkin* at least because it depends from claim 62 and adds features thereto.

For at least these reasons, Applicant respectfully submits that claims 33, 35, 38, 41, 42, 44, 62 and 64 are allowable over *Bufkin*.

Gazel-Anthoine

The Examiner rejected claims 33-35, 38, 42-48, 51, 53-55, 62 and 64 as being anticipated by *Gazel-Anthoine*. *Gazel-Anthoine* discloses a wrench 11 for handling pipe. The wrench 11 includes cam assemblies 18 that pivot about an axis A'. The cam assemblies 18 are supported by

plates 22. A cam assembly 18 includes a gear 36 attached to a rotatable shaft 35 and two flanges having symmetrical profiles 28H, 28AH. Each profile 28H, 28AH includes housings 32 containing jaws 30. The jaws 30 have teeth or ribs 33. The gears 36 are constrained to rotate with the shafts 35, and all of the gears 36 of the cam assemblies 18 mesh with a synchronizer ring 38.

With respect to claim 33, the claimed gripping apparatus includes a cam member having a first camming surface and a second camming surface. The cam assembly 18 of *Gazel-Anthoine* cannot disclose the claimed cam member because an assembly is not a member. By definition, a member is a constituent part of any structural or composite whole, such as an element of a set. *Dictionary.com Unabridged (v.1.1)*, Random House, Inc., http://dictionary.reference.com-/browse/member (accessed: November 9, 2007). An assembly, by contrast, is a group of machine parts that are put together. *Dictionary.com Unabridged (v.1.1)*, Random House, Inc., http://dictionary.reference.com/browse/assembly (accessed: November 9, 2007). Therefore, the cam assembly 18 does not disclose the claimed cam member.

Further with respect to claim 33, the claimed gripping apparatus includes a cam member disposed between the insert holder and the insert, the cam member having a first camming surface that rotationally engages an inner surface of the insert while a second camming surface rotationally engages a surface of the insert holder. Aside from the distinguishing characteristic of the *Gazel-Anthoine* cam 18 being an assembly rather than a member, there is no cam member having the claimed features disposed between the insert 30 having the teeth 33 and the holding members 29V, 29D. Moreover, the cam surfaces 32, 36 of *Gazel-Anthoine* cited by the Examiner do not reside on the same member, nor does the second cam surface 36 rotationally engage the insert holder (instead, it is a gear surface that meshes with the surface of the synchronizer ring 38).

With respect to claim 45, the claimed gripping apparatus includes a cam member having a first curved camming surface and a second curved camming surface, wherein the cam member is disposed between the insert holder and the insert and the first camming surface engages the insert and the second camming surface engages the insert holder such that the cam member is rotatable relative to both the insert and the insert holder. First, as explained, *Gazel-Anthoine* discloses a cam assembly, which does not teach the claimed cam member. Next, no constituent part of the cam assembly 18 serves as the claimed cam member, as no cam member is disposed between the inserts 30 and the holders 29V, 29D of *Gazel-Anthoine*, nor do the cam surfaces 32, 36 cited by the Examiner reside on a single cam member such that they engage the insert and insert holder and rotate the cam member as claimed.

With respect to claim 62, the claimed method includes forcing the insert against the first curved camming surface of the cam member and forcing the second curved camming surface against the insert holder, thereby rotating the cam member and intensifying the gripping force. As previously explained, the *Gazel-Anthoine* arrangement does not include a cam member as claimed, but rather a cam assembly wherein the cam surfaces 32, 36 do not relate to the insert and insert holder to provide the functions as claimed.

For at least these reasons, *Gazel-Anthoine* does not anticipate independent claims 33, 45 and 62. Claims 34, 35, 38, 42 and 44 are not anticipated by *Gazel-Anthoine* at least because they depend from claim 33 and add features thereto. Claims 46-48, 51, 53 and 55 are not anticipated by *Gazel-Anthoine* at least because they depend from claim 45 and add features thereto. Claim 64 is not anticipated by *Gazel-Anthoine* at least because it depends from claim 62 and adds features thereto.

For at least these reasons, Applicant respectfully submits that claims 33-35, 38, 42-48, 51, 53-55, 62 and 64 are allowable over *Gazel-Anthoine*.

Dlask

The Examiner rejected claims 33-35, 38, 42, 44-48, 51, 53, 55 and 62-64 as being anticipated by *Dlask*. *Dlask* discloses a wrench body 20 that supports a jaw frame assembly 30 having a roller or cam follower 32, die holders 40 and die inserts 50.

With respect to claim 33, the claimed gripping apparatus includes a cam member having a first camming surface and a second camming surface. The Examiner identifies the assembly 30 as the cam member. However, as previously explained, an assembly cannot be a member.

Further with respect to claim 33, the claimed gripping apparatus includes a cam member disposed between the insert holder and the insert, the cam member having a first camming surface that rotationally engages an inner surface of the insert while a second camming surface rotationally engages a surface of the insert holder. The first cam surface 34 of *Dlask* does not engage the inner surface of the insert 50. Further, the first cam surface 34 and the second cam surface 32 are not on the same cam member. Lastly, the second cam surface 32 does not engage a surface of the insert holder, as the cam roller 32 includes a roller and pin arrangement similar to that taught by *Bufkin* wherein the cam surface 32 only engages the cam surface 22. See Figure 4 of *Dlask*.

With respect to claim 45, the claimed gripping apparatus includes a cam member having a first curved camming surface and a second curved camming surface, wherein the cam member is disposed between the insert holder and the insert and the first camming surface engages the insert and the second camming surface engages the insert holder such that the cam member is rotatable relative to both the insert and the insert holder. First, *Dlask* discloses a cam assembly, which does not teach the claimed cam member. Next, no constituent part of the cam assembly 30 serves as the claimed cam member, as no cam member is disposed between the inserts 50 and the holders 40. Finally, the cam surfaces 32, 34 cited by the Examiner do not reside on a single

cam member such that they engage the insert and insert holder and rotate the cam member as claimed.

With respect to claim 62, the claimed method includes forcing the insert against the first curved camming surface of the cam member and forcing the second curved camming surface against the insert holder, thereby rotating the cam member and intensifying the gripping force. As previously explained, the *Dlask* arrangement does not include a cam member as claimed, but rather a cam assembly wherein the cam surfaces 32, 34 do not relate to the insert and insert holder to provide the functions as claimed.

For at least these reasons, *Dlask* does not anticipate independent claims 33, 45 and 62. Claims 34, 35, 38, 42 and 44 are not anticipated by *Dlask* at least because they depend from claim 33 and add features thereto. Claims 46-48, 51, 53 and 55 are not anticipated by *Dlask* at least because they depend from claim 45 and add features thereto. Claims 63 and 64 are not anticipated by *Dlask* at least because they depend from claim 62 and add features thereto.

For at least these reasons, Applicant respectfully submits that claims 33-35, 38, 42, 44-48, 51, 53, 55 and 62-64 are allowable over *Dlask*.

Allowable Subject Matter

Applicant appreciates the allowance of claims 56-61, and the allowability of claims 36, 37, 39, 40, 49, 50 and 52, but respectfully requests the Examiner to reconsider all objected to and rejected claims in view of the foregoing.

CONCLUSION

Applicant respectfully requests reconsideration and that a timely Notice of Allowance be issued in this case. No new matter is introduced by way of amendment. It is believed that all rejections in the Office action dated September 14, 2007 have been fully addressed. It is believed that no extensions of time or fees are required, beyond those that may otherwise be

provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Conley Rose, P.C.'s Deposit Account Number 03-2769 (1814-19001).

Respectfully submitted,

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